

**REMARKS/ARGUMENTS**

This paper is in response to the Office Action dated January 30, 2004. This amendment is timely filed as it is accompanied by a petition for a two month extension of time and the requisite fees therefore, extending the response date to June 1, 2004 (May 30, 2004 being a Saturday and May 31, 2004 being a PTO Holiday).

Status of Claims:

Claims 1-60 are pending in the present application. With the Office Action, the Examiner has allowed claims 30-37. The Examiner has objected to claim 40 as being dependent upon a rejected base claim. Claims 1-7, 9-11, 13-15, 17 and 18 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,480,706 issued to Mimura et al. (hereinafter "Mimura"). Claims 8, 12 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mimura. Claims 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mimura in view of U.S. Patent No. 5,604,925 issued to O'Malley et al. (hereinafter "O'Malley"). Furthermore, claims 22-29, 38, 39 and 41-60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mimura in view of O'Malley. The applicant traverses such rejections and respectfully requests reconsideration.

Claims 1, 22, 38 and 47 and their dependent claims are allowable:

Claims 1, 22, 38 and 47 recite, *inter alia*, a system including a receive path carrying reception signals from an antenna and a transmit path carrying transmission signals from a communication station, wherein the receive path and the transmit path are coupled between the system and the antenna and wherein the receive path and the transmit path are coupled between the system and the communication station via a duplexer. The system recited in these claims uses only a single cable to connect the communication station to the system, allowing easy and efficient connection of such system installed on a tower top, closer to the antenna, while the communication station is located at a base station. Such a single connection between the system and the communication station is possible because of the duplexer between the system and the communication station.

While Mimura discloses a radio receiver including a receive path carrying reception signals from an antenna and a transmit path carrying transmission signals to the antenna where the reception signals and the transmission signals are coupled between the receiver and the antenna, Mimura does not disclose using a duplexer to couple the receive path and the transmit path between the receiver and a communication station, as recited by the claims 1, 22, 38 and 47. Instead, Mimura discloses separate input and output terminals for the radio receiver where the input terminals carrying a transmission signal to the radio receiver and the output terminals carrying the reception signals from the radio receiver are not connected to each other at all. See Figs. 4-6, 8, 10-11, 16-17 of Mimura. Using the radio receiver disclosed in Mimura on a tower top system would require that separate cables are run from the radio receiver to a communication station; adding cost and complexity to a communication system using the radio receiver. Therefore, claims 1, 22, 38 and 47 are not anticipated by Mimura.

Similarly, while O'Malley discloses a multi-coupler system having a coupler to recombine a transmit path and a receive path, the coupler disclosed in O'Malley is a directional coupler, not a duplexer as recited in claims 1, 22, 38 and 47. It is well known to one of ordinary skill in the art that while a directional coupler can separate signals based on direction of propagation, a directional coupler cannot duplex multiple input signals on a single output line, in a manner that a duplexer can. The multi-coupler system disclosed in O'Malley acknowledges such deficiency of the directional coupler as it uses an isolator to isolate transmit power on the receive path from a receive path amplifier. See Fig. 3, Col.4:53-55. Because O'Malley does not teach using a duplexer to couple the receive path and the transmit path in a manner recited in claims 1, 22, 38 and 47, O'Malley cannot provide any teaching, motivation or suggestion to modify the system provided in Mimura to include a duplexer to couple the receive path and the transmit path in a manner recited in claims 1, 22, 38 and 47.

It is well established that the prior art must teach or suggest each of the claim elements and must additionally provide a suggestion of, or an incentive for, the claimed combination of elements to establish a prima facie case of obviousness. See *In re Oetiker*, 24 USPQ. 2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 USPQ. 972, 973 (Bd. Pat. App. 1985); *In re Royka*, 490 F.2d 981 (CCPA 1974) and M.P.E.P. § 2143. Because neither

**Application No.: 09/810,291**

**Docket No.: 28349/10074**

Mimura nor O'Malley teach or suggest a combination of elements as recited in claims 1, 22, 38 and 47, it follows that Mimura and O'Malley, whether taken individually or in combination, do not render claims 1, 22, 38 and 47 obvious. Therefore, claims 1, 22, 38 and 47 and their dependent claims are allowable over Mimura and O'Malley.

Conclusion:

For the reasons cited above, it is respectfully submitted that the claims 1-60 are in condition for allowance. If, for any reason, the examiner is unable to allow the application in the next Office Action, the examiner is encouraged to telephone the undersigned attorney at the telephone number listed below to discuss this matter.

Dated: June 1, 2004

Respectfully submitted,

By

  
Chirag B. Patel

Registration No.: 50,555

MARSHALL, GERSTEIN & BORUN LLP

233 South Wacker Drive, Suite 6300

Chicago, IL 60606

(312) 474-6300

Attorneys for Applicant